

REMARKS

In the Office Action mailed December 28, 2006, restriction was required between claims 2-10, 12-16, 19-28 (Group I) and claim 18 (Group II). This Restriction Requirement is respectfully traversed. Applicants provisionally elect claims 2-10, 12-16 and 19-28, the Examiner's Group I for prosecution, with traverse.

Applicant believes that the Restriction Requirement is inappropriate because the Examiner has not met his burden of showing that the inventions are either independent and distinct as claimed or that there is a serious burden on the Examiner if restriction is required.

35 U.S.C. § 121 reads in pertinent part as follows:

§ 121 Divisional Applications

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the two inventions. . . .

This language of the statute has been replicated in 37 C.F.R. § 1.141 (a):

§ 1.141 Different inventions in one national application.

Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

Restriction is proper to one or more claimed inventions only if they are able to support separate patents and they are either independent or distinct. MPEP 803. The Examiner has the burden of demonstrating by *reasons* that a restriction requirement meets the statutory requirements. The Examiner must support his restriction requirement with reasons, not by a statement of conclusions. MPEP 808.

Every requirement for restriction has two aspects: (A) the reasons (as distinguished from mere statement of conclusion) why the inventions *as claimed* are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween as set forth in the following sections. (Emphasis original).

MPEP 808.

The Examiner has not supported his restriction requirement because he has not demonstrated that the subject matter of the *claims* relating to each of the classes are able to support separate patents. Further, the Examiner has failed to identify any reasons (as distinguished from mere statements of conclusion) as to why the inventions *as claimed* are either independent or distinct. The Examiner has not met his burden for requiring restriction.

Further, the Examiner has not met his burden for the restriction requirement because it has not been shown that there is a serious burden on the Examiner if the claims are not restricted.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent or distinct as claimed [citations omitted]; and
- (B) There must be a serious burden on the Examiner if restriction is required [citations omitted].

MPEP 803.

The Examiner is correct that the two groups of claims do relate to processes which are mutually exclusive. However, they are so closely related in subject matter that they are classified in the same class and subclass. Contrary to the Examiner's representation, neither of the sets of method claims are classified in class 15, subclass 320 or subclass 328. The examiner's attention is invited to the definition of these two subclasses which are reproduced as follows:

320

With liquid or other cleaning material application to work:

This subclass is indented under subclass 300.1. Cleaning apparatus having means to apply liquid and/or particulate or comminuted solid cleaning material to the work.

- (1) Note. Many of these devices pick up the liquid or other cleaning material by air draft means, such pickup being the only air draft contact with the work.

328

Convertible:

This subclass is indented under subclass 300.1. Cleaning apparatus, which, by addition or removal or change in position of parts, may be converted in whole or in part (1) to noncleaning apparatus, or (2) to cleaning apparatus without air-draft means; also, cleaners capable of applying an air-draft in two or more distinct types of operations, each being exercised alternatively and selected by addition or removal or change in position of parts.

The definition of Subclass 300.1 reads as follows:

300.1

With air blast or suction:

This subclass is indented under subclass 3. Subject matter having claimed structure functioning to contact a work piece or work surface with a draft of air, steam, or equivalent gaseous fluid for the purpose of dislodging or removing unwanted foreign material therefrom.

(1) Note. In this and the indented subclasses, the term "air" is used generically to designate air, steam, or equivalent gaseous fluid.

(2) Note. The draft of air need not be the primary cleaning or dislodging means; this and the indented subclasses include devices wherein means are provided for brushing, beating, shaking, or otherwise manipulating the work to dislodge the foreign material and wherein the draft of air acts to convey away the material so dislodged, or any portion thereof, provided only that the draft of air must contact the work.

(3) Note. Where an air draft is used as a means to feed material to or discharge material from an art device, the patent is in general classified with the device, even though a vacuum pickup is used on an ambulatory device; except that a gas separator of the Class 96 type is classified in this class (15) if claimed in combination with means for applying an air-draft to a workpiece or work surface.

(4) Note. Where an air draft functions to perfect the operation of an art device, the patent is classified with the art device.

These subclasses relate to apparatus while the claims relate to methods. Clearly these claims are not classified in these subclasses. However, subclass 320 appears to be appropriate classification for an apparatus for carrying out both sets of method claims and clearly would appear to be a relevant area of search for both sets of method claims. However, subclass 328 is not in any way related to either set of claims. Neither of the sets of claims is related to a conversion from one form of apparatus to another. The Examiner is requested to articulate his

reasons for selecting both subclasses, and in particular subclass 328 for his restriction requirement.

Furthermore, it is clear that both sets of claims have more in common than differences and would likely be classified in the same class and subclass. It is noted that the application was originally classified in class 8, subclass 11 (probably should be subclass 111) although that seems inappropriate as well because it relates to bleaching with peroxides or oxygen. Both sets of claims are method claims. Both sets of claims relate to extraction in which a fluid is dispensed onto a surface to be cleaned. Further, both sets of claims require admixing of an oxidizing agent with a cleaning solution prior to dispensing the cleaning solution onto a surface to be cleaned. Claim 21 differs from claim 18 in calling for heating the cleaning solution before the admixing step and claim 18 calls for mixing the admixture of cleaning solution and the oxidizing agent with heated air to heat the admixture. These distinctions, although exclusive, do relate to overlapping subject matter in the sense that the bulk of each method claim is identical. Although there are distinguishing features between each set of claims, the subject matter is very closely related and would require the same areas of search as demonstrated above as indicated by the classification of apparatus for carrying out each set of claims.

In addition, the Examiner has not met his burden of showing that there would be a serious burden on the Examiner if restriction is not required. Applicants believe that a different field of search is not required because of the significant overlap in the subject matter. Furthermore, the Examiner's assertion that examination of both classes would be a burden on the Examiner is belied by the history of the prosecution of this application. The prosecution history of the claims subject to restriction is relevant to the issue of the alleged burden on the Examiner. Each of the independent claims 18 and 21 are original claims which were filed in U.S. Patent and Trademark office on June 8, 2000, *more than 6 1/2 years ago*. These claims have been examined by the Patent Office on the merits as follows:

- Office Action dated February 27, 2002;
- Office Action dated August 14, 2002;

- Office Action dated January 29, 2003;
- Advisory Action dated May 29, 2003;
- Response to Request for Reconsideration dated August 2, 2003;
- Reply Brief on Appeal dated November 18, 2003;
- Rejection January 9, 2006; and
- Final Rejection June 12, 2006.

Thus, these claims have been of examined by the Patent Office, including in part the Examiner in charge of this application, no less than *eight times* over a period of *almost 5 years*. It is ludicrous for the Examiner to assert that it would be burdensome for him to examine these two sets of claims when in fact he has already done so and so has an examiner who was assigned to the case prior to the current Examiner over a period of 5 years and have been rejected on different sets of references. The prosecution history in this application belies the Examiner's assertion that examination of both sets of claims in this application would be burdensome on the Examiner.

In view of the foregoing, it is submitted that the Examiner has not met his burden of showing proper restriction in this case, especially in view of the long prosecution history. The Examiner is reminded that the Board of Appeals has allowed both sets of claims on essentially the same art that the Examiner has cited. Furthermore, the Examiner's Final Rejection has essentially been overturned by the decision of the panel decision in a Pre-Appeal Brief Review on Applicant's second Appeal to the Board of Appeals. The Examiner is requested to follow the Rules of Practice in the Patent Office and cease interposing inappropriate procedural delays to allowing the claims of this application.

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Examiner: Necholas Ogden Jr.
Group Art Unit: 1751

In view for the foregoing, it is submitted that the restriction requirement is inappropriate and should be withdrawn.

Respectfully submitted,

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